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EXAMINER

LIN, JEYUHU

ART UNIT PAPER NUMBER

3737

DATE MAILED: 02/03/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,600

Applicant(s)

SCOTT ET AL.

Examiner

Jeoyuh Lin

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 21 October 2003.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-7, 9, 10, 12, 13 and 15-17 is/are rejected.

7) ☒ Claim(s) 8, 11, and 18 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Entry of Amendment**

1. Applicant's amendment, filed on October 21, 2003, as paper No. 12, is acknowledged. Claims 1-13 and 15-18 are currently pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

-Claims 1 and 13 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. In claim 1, line 4, and claim 13, line 6, the applicants claim, "electrodes" to detect magnetic resonance signals. However, electrodes are commonly known to detect electrical energy only and are incapable of detecting magnetic resonance signals, as magnetic resonance "coils" detect or radio-frequency energy, as in "antennas". Therefore, the electrodes are inoperative in detecting magnetic resonance signals and thus lack utility.

### ***Claim Objections***

3. Claims 1 and 3 are objected to because of the following informalities:

-In claim 1, line 1, the term, "form" should be changed to, "from".

-Also claim 1, the inventors appear to claim "conducting medium" as a structure.

To clarify the position not to claim the structure, please insert, "adapted" between "probe" and "for" in line 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

-Claims 1-6, 9, 13, and 16 rejected under 35 U.S.C. 102(e) as being anticipated by Ocali et al. (US 5,928,145)

Ocali teaches a magnetic imaging imager employing loopless antennas, comprising the following:

- At least first and second electrodes (understood to mean antennas) and positionable on or within the object in proximity to the region of interest, distal ends of the electrodes being spaced apart and disconnected, and incorporated into a catheter, (Column 14, lines 16-49) as in claims 1, 2, 5, 6, 9 and 13. (Figure 3 and column 9, lines 40-60)
- Feed wires coupling the proximal ends of the electrodes to a signal detector, or a receiver (Column 9, line 54)
- Wherein the signals are emitted from tissue, or from bodily fluid, as in claims 3 and 4. (Column 11, lines 5-20)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

-Claims 7, 10, 12, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ocali.

Ocali meets all the claims except that it fails to teach having the electrodes in the shape of rings or in needle form. However, without statements of criticality of the shape of the electrodes it is an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to form the electrodes of a particular shape or reduce their circumference to such that one of skilled in the art may refer to them as, "needles" such that they may fit on a catheter for insertion into the body.

***Allowable Subject Matter***

6. Claims 8, 11, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-13 and 15-18 have been considered but are moot in view of the new ground(s) of rejection.

The examiner notes that the applicants do not intent claim the "conducting medium", which are limited to, "tissue" or bodily "fluid", and that the applicants

intend to define the environment of the probe. However, the language as-is inferentially claims the human body. The examiner suggests use of the word, "adapted" to overcome this issue.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeoyuh Lin whose telephone number is (703) 306-5990. The examiner can normally be reached on m-f, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JYL

JYL  
January 28, 2004

  
DENNIS W. RUHL  
SUPERVISORY PATENT EXAMINER